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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/063,398	04/18/2002	John Bradford Reitz	RD29180-2	7869
23413	7590	09/15/2005	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			TUROCY, DAVID P	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 09/15/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

7-D
✓

Office Action Summary	Application No. 10/063,398	Applicant(s) REITZ ET AL.	
	Examiner David Turocy	Art Unit 1762	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 July 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-17 and 37-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-17 and 37-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/20/2005 has been entered.

Response to Amendment

2. The applicant's amendments, filed 7/20/2005, have been fully considered and reviewed by the examiner. The examiner notes the amendments to the claims and the addition of new claims 43-52. Claims 1-7, 9-16 and 37-53 are pending.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

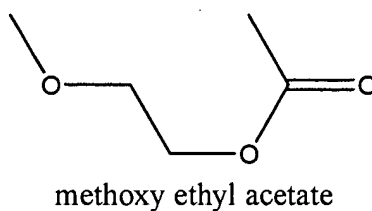
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 7, 9-11, 14-17, 38, and 51-53 are rejected under 35 U.S.C. 102(b) as being anticipated by Meshina et al. (US 5,916,632).

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Meshina et al. discloses a polyimide coating solution that may be applied by spin coating, (col. 4, lines 45-46), whereby the solution comprises 5-50 wt% polyimide polymer resin (col. 4, lines 31-32) and two solvents in a solvent system, whereby the solution contacts the substrate and the solvent is removed to form a coating. Meshina et al. teaches that one of the solvents may be selected from N-methyl pyrrolidone, N,N-dimethylacetamide, N,N-dimethylformamide, dimethylsulfoxide, or butyrol actone (col. 4, lines 6-13) -- each of which has a boiling point in the claimed range, a polarity index of greater than or equal to about 4.0, and a pH in the range of 5.5-9, as evidenced by Applicant's own specification and dependent claim 9.

The examiner notes the solution solvent of Meshina is inclusive of a propylene glycol derivative of the formula (I), where n is 1 or 2, R is a hydrogen, C₁₋₄ alkyl group, C₁₋₄ alkenyl group, or a C₁₋₄ alkanoyl group. Therefore Meshina discloses the propylene glycol derivative is inclusive of alkoxy alkyl acetates by selecting n=1 and R to be C₁₋₄ alkanoyl group and C₁₋₄ alkyl group, including methoxy ethyl acetate, selecting n=1 and R to be C₁ alkanoyl group and C₂ alkyl group.



Therefore Meshina et al. teaches of a solution solvent consisting of miscible combinations as claimed.

While Meshina et al. is silent with regard to the number of asperities or the height of the asperities in the final coating, it is the Examiner's position that the final coating of

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Meshina et al.'s process would necessarily have less than or equal to 10 asperities, each with a height as claimed, because the process steps and materials of Meshina et al. are materially similar to the claimed process. Any differences in properties between the claimed invention and that of Meshina et al. must have been caused by process variables not claimed in the instant application. The prior art and the present claims teach all the same process steps and thus the results obtained by applicants process must necessarily be the same as those obtained by the prior art. Therefore by spinning a solution of a solvent and a thermoplastic polymer, it must necessarily result in a film with less than or equal to 10 asperities, each with a height as claimed. Either 1) the applicant and the prior art have different definitions for a spin coating, or 2) the applicant is using other process steps or parameters that are not shown in the claims.

As to claims 10, 14, and 16, it is noted that the solvents listed above do not comprise halogens, nor does the coating solution comprise the claimed particles or water. However, it is noted that the claims are broad enough to read on 0 wt% halogens, 0 wt% particles, and 0 wt% water.

As to claim 11, the solvents of Meshina et al. must necessarily have the claimed dielectric constant since the solvents taught by Meshina et al. are among the solvents disclosed in the specification.

As to claims 15 and 17, Meshina et al. is silent with regard to the peel strength and haze level. However, as discussed above, the process steps and materials of Meshina et al. are materially similar to the claimed process, therefore the coating of

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Meshina et al. must necessarily have the claimed peel strength and haze level. Any differences in properties between the claimed invention and that of Meshina et al. must have been caused by process variables not claimed in the instant application.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-6, 12-13, 37, 42-44 and 47-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meshina et al.

Meshina et al. is applied for the reasons set forth above in section 4.

As to claims 2-6, 42-44, and 47-48, Meshina et al. is silent with regard to the weight average molecular weight and Tg of the polyimide resin. It would have been obvious to one skilled in the art to have selected an optimal polyimide material depending upon the end use and desired qualities of the resulting coating in the absence of a showing of criticality. It is also noted, with regard to claims 4-5 and 37, that Meshina et al. does not teach the use of a polyimide having carboxylic acid functional groups, and the claims are broad enough to read on a polymer having no carboxylic acid functional groups.

As to claims 12-13, Meshina et al. is silent with respect to its coating solution's viscosity. Coating viscosity is a known cause-effective variable. It would have been

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obvious for one skilled in the art to have optimized the viscosity through routine experimentation depending upon the desired coating thickness, the spin speeds and times used, etc. in the absence of a showing of criticality.

7. Claims 45-46 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6715200 by Feist et al. in view of Meshina et al.

Feist et al, teaching of a method for making data storage unit, discloses plastics that exhibit appropriate properties can be utilized as a coating on the disc (Column 10, lines 1-2). Feist et al. discloses applying a coating by spin coating using a solution containing a resin and a solvent (Column 12, lines 25-36). Feist et al. discloses such resins include polyimides, polysulfones and polyethersulfones (Column 10, lines 10-20). Feist et al. discloses that such resin coatings on data storage discs are known in the art to be equivalents. Feist fails to disclose the solvent as claimed.

However, Meshina et al. is applied for the reasons set forth above in section 4 and 6, in addition Meshina discloses providing the solution solvent and resin results in a uniform film on a substrate by spinning.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Feist to use the resin/solvent solution as suggested by Meshina to provide a desirable coating on a storage device to reap the benefits of a uniform coating with the reasonable expectation of success.

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Fiest in view of Meshina fails to explicitly disclose a surface area of 6500 mm². However, Fiest discloses a typical storage disk has a inner diameter ranging from 15-40 mm and an outer diameter from 65-130 mm, which results in a surface area ranging from 3140 mm² to about 12010 mm², which is inclusive of the surface area claimed. In the case where the claimed ranges "overlap or lie" inside ranges disclosed by prior art a *prima facie* case of obviousness exists. *In re Wertheim*, 541 F.2d 257 191 USPQ 90. See MPEP 2144.05.

8. Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meshina et al. in view of US Patent 6715200 by Feist et al. and further in view of US Patent 5055631 by Sartori et al.

Meshina et al. is applied for the reasons set forth above in section 4 and 6.

Meshina et al. fails to teach of a thermoplastic polymer consisting of polysulfones and/or polyethersulfones. However, Feist et al, teaching of a method for making data storage unit, discloses plastics that exhibit appropriate properties can be utilized as a coating on the disc (Column 10, lines 1-2). Feist et al. discloses applying a coating by spin coating using a solution containing a resin and a solvent (Column 12, lines 25-36). Feist et al. discloses such resins include polyimides, polysulfones and polyethersulfones (Column 10, lines 10-20). Feist et al. discloses that such resin coatings on data storage discs are known in the art to be equivalents. Substitution of equivalents requires no

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express motivation. *In re Fount*, 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152, USPQ (CCPA 1967).

Meshina et al in view of Feist et al. teach of applying a polysulfone resin coating by solution using a solvent, but fail to disclose a proper solvent to prepare a solution including a polysulfone.

However, Sartori et al., discloses a dimethyl-formamide is known in the art to properly dissolve polysulfone into a solution capable of forming coatings (Column 3, lines 41-46). Dimethyl-formamide has a boiling point in the claimed range, a polarity index of greater than or equal to about 4.0, and a pH in the range of 5.5-9, as evidenced by Applicant's own specification and dependent claim 9

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Meshina et al in view of Feist et al. to use the dimethyl-formamide solvent suggested by Sartori et al. to provide a desirable solution containing solvent and resin because Sartori et al. discloses dimethyl-formamide is known in the art to be a solvent for polysulfones and therefore would reasonably be expected to effectively provide a solution of polysulfones and solvent for application as a coating to a recording media.

9. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meshina et al. in view of US Patent 6715200 by Feist et al. and further in view of Japanese Patent Abstract 1991-017337 by Kageyama et al.

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Meshina et al. is applied for the reasons set forth above in sections 4 and 6.

Meshina et al. fails to teach of a thermoplastic polymer consisting of polysulfones and/or polyethersulfones. However, Feist et al, teaching of a method for making data storage unit, discloses plastics that exhibit appropriate properties can be utilized as a coating on the disc (Column 10, lines 1-2). Feist et al. discloses applying a coating by spin coating using a solution containing a resin and a solvent (Column 12, lines 25-36). Feist et al. discloses such resins include polyimides and polycarbonates (Column 10, lines 10-20). Feist et al. discloses that such resin coatings on data storage discs are known in the art to be equivalents. Substitution of equivalents requires no express motivation. *In re Fount*, 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152, USPQ (CCPA 1967).

Meshina et al in view of Feist et al. teach of applying a polycarbonates resin coating by solution using a solvent, but fails to disclose a proper solvent to prepare a solution including a polycarbonates.

However, Kageyama et al., discloses a cresol is known in the art to properly dissolve polycarbonates into a solution capable of forming coatings (Abstract). Cresol has a boiling point in the claimed range, a polarity index of greater than or equal to about 4.0, and a pH in the range of 5.5-9, as evidenced by Applicant's own specification and dependent claim 9

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Meshina et al in view of Feist et al. to use the cresol solvent suggested by Kageyama et al. to provide a desirable solution containing solvent and

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resin because Kageyama et al. discloses cresol is known in the art to be a solvent for polycarbonates and therefore would reasonably be expected to effectively provide a solution of polycarbonate and solvent for application as a coating to a recording media.

10. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Meshina et al. in view of US Patent 6715200 by Feist et al. and further in view of US Patent 5589523 by Sawaoka et al. and US Patent 4842740 by Chung et al.

Meshina et al. in view of Feist et al is applied for the reasons set forth above in sections 8 and 9 above.

Meshina et al. in view of Feist et al. fails to teach of a thermoplastic polymer consisting of polyphenylene ethers and/or polyarylates. However, Sawaoka et al, teaching of known thermosetting resins, discloses resins such as polyarylate, polycarbonate, polyimide, and polysulfone. Sawaoka et al discloses that such thermosetting resin coatings are known in the art to be equivalents. Substitution of equivalents requires no express motivation. *In re Fount*, 213 USPQ 532 (CCPA 1982); *In re Siebentritt* 152, USPQ (CCPA 1967).

Meshina et al in view of Feist et al. and further in view of Sawaoka et al teach of applying a polyarylate resin coating by solution using a solvent, but fails to disclose a proper solvent to prepare a solution including a polyarylate.

However, Chung et al discloses N,N-dimethyl formamide, N,N-dimethyl acetamide, dimethyl sulfoxide are known in the art to properly dissolve polyarylate into a

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solution capable of forming coatings (Column 6, lines 41-47). N,N-dimethyl formamide, N,N-dimethyl acetamide, dimethyl sulfoxide has a boiling point in the claimed range, a polarity index of greater than or equal to about 4.0, and a pH in the range of 5.5-9, as evidenced by Applicant's own specification and dependent claim 9

Therefore, it would have been obvious to one skilled in the art at the time of the invention to modify Meshina et al in view of Feist et al. and further in view of Sawaoka et al to use solvent suggested by Chung et al to provide a desirable solution containing solvent and resin because Chung et al discloses N,N-dimethylformamide, N,N-dimethylacetamide, dimethylsulfoxide are known in the art to be a solvent for polyarylates and therefore would reasonably be expected to effectively provide a solution of polyarylates and solvent for application as a coating to a recording media.

Conclusion

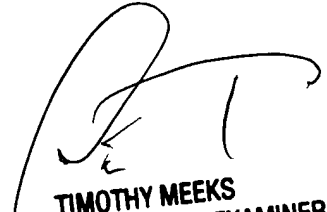
Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Turocy whose telephone number is (571) 272-2940. The examiner can normally be reached on Monday-Friday 8:30-6:00, No 2nd Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Turocy
AU 1762



TIMOTHY MEEKS
SUPERVISORY PATENT EXAMINER